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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,669	03/14/2002	Joseph D. Franko SR.	20020049.ORI	3004
23595	7590	11/04/2003	EXAMINER	
NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 10/26/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-28 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-28 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention, substantially for the reasons set forth in paragraph No. 4 of Paper No. 4, together with the following additional observations. Applicant's characterization of "permanent adhesives" seems simply to be based on the vague proposition that they are "non-pressure sensitive adhesive materials" (Response, page 10, middle paragraph), and also as "tack-free in the cured or final adhesive state". Also, applicant supplements this argument with (Response, page 12) the vague statement that a permanent adhesive is "an adhesive characterized by relatively high ultimate adhesion. Sometimes it can be removed when the degree of force used overcomes its bonding ability but generally is not removable". In summary, applicant also argues (Response, page 12, bottom paragraph) that a "permanent" adhesive forms "a much stronger adhesive bond, normally to the point of being non-removable". However, the Examiner must respectfully submit that such a vague standard is simply an invitation to experiment and that a perspective infringer has no guidelines as to indicate

which sort of adhesives would or would not read upon applicant's disclosed and also claimed genus of adhesives. Finally, note that the "permanent adhesive material" as set forth in applicant's claim 2 Markush grouping is also believed to recite five subgenuses of adhesives, each of which also contain multiple pressure sensitive adhesives as members thereof.

3. Claims 1-28 are rejected under 35 U.S.C. § 112, first paragraph as being based upon a non-enabling disclosure.

4. Claims 1, 2, 4-6, 9 and 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Baum, Jr. et al., substantially for the reasons set forth in paragraph No. 9 of Paper No. 4, together with the following additional observations. The Examiner believes that if "permanent adhesives" that are "tack-free" are not expressly or inherently disclosed by the reference they are believed to be at most an obvious modification to one of ordinary skill. Note again column 3 lines 49-51 where it is taught that "adhesive means 28 may be a pressure sensitive adhesive layer or another adhesive system as is known in the art". Note also that adhesive 44 may also be modified, which presumably means that either pressure sensitive adhesives or permanent adhesives as claimed by applicant may be suitable.

5. Claims 3, 7, 8, 10 and 12-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum, Jr. et al.,

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substantially for the reasons set forth in paragraph No. 10 of Paper No. 4 together with the following additional observations. The reference is again relied upon as set forth above, with such variations each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

6. Claims 1, 2, 4-6, 9 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Coward et al. or Hill et al. -587, substantially for the reasons set forth in paragraph No. 12 of Paper No. 4, together with the following additional observations. With respect to applicant's arguments concerning the distinction between pressure sensitive adhesives and permanent adhesives, note the Abstract of Coward et al. which, at the very least, indicates that the two terms appear to be interchangeable. Also, note Hill, column 3 lines 24-28 wherein it is taught that pressure sensitive adhesives "function to effect secure afixment bonding of the pressure sensitive adhesive label 16 to the base layer 20" which again appears to read upon applicant's definition of permanent adhesives. What other parameters that may exist are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

7. Claims 3, 7, 8, 10 and 12-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Coward et al.

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or Hill et al. -587, substantially for the reasons set forth in paragraph No. 13 of Paper No. 4, together with the following additional observations. Initially the Examiner notes that he intended Hill et al., not Baker et al. to be relied upon in the previous rejection, but applicant appears to not have been deceived. In any event, the references are each again relied upon substantially as set forth above, with those parameters that are not believed to be either expressly or inherently disclosed are again handled in the identical manner as previously set forth above.

8. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending application

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Serial No. 10/294,287. Although the conflicting claims are not identical, they are not patentably distinct from each other because what minor differences that may exist such as the recitation of "tack-free" permanent adhesives and "tacky" pressure sensitive adhesives, as well as claims 3-5 of the application being dependent upon claim 2 instead of claim 1 are each believed to be clearly obvious parameters, to one of ordinary skill, if indeed not inherent so that 35 U.S.C. § 101 double patenting might also apply.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

October 23, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1800
1700

Daniel Zinker